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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/592,087 | 06/12/2000 | Tariq Khalidi | 10015-pa | 4895 |

37095 7590 07/13/2005

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EXAMINER

PATEL, JAGDISH

| | |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3624

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

59

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|------------------------------|-----------------|----------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/592,087 | KHALIDI, TARIQ | |
| | Examiner | Art Unit | |
| | JAGDISH PATEL | 3624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/31/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 12-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 12-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

[Handwritten signature]

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DETAILED ACTION

1. This communication is in response to amendment filed 3/31/2005.

Response to Amendment

2. Claims 1, 2, 5, 12-14 and 19 have been amended. Claims 1-7 and 12-19 are currently pending.

Response to Arguments

3. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejections.

Response to Arguments

3. Applicant's arguments filed 3/31/2005 have been fully considered but they are not persuasive.

The applicant argues that Cook does not disclose modules. The examiner disagrees with this interpretation. The term "module" is defined by the applicant (see p. 24 of the Specification) as "an element of discrete, standalone product or service that can be fragmented away from within the remaining bid package". Furthermore the claim further

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recites that the bid package is sequestered into a plurality of module wherein a module constitute a portion of the bid package. Cook discloses that a general contractor who is preparing a bid for a complex project solicits proposals from subcontractors and suppliers. This process inherently involves sequestering (breaking down or decomposing) a bid package (solicited from a customer of the general contractor requesting a bid for the complex project) into modules (a portion of the original bid package) which are allocated among the subcontractors for which bids are solicited. (see pp.1-4). Therefore, it is concluded that:

(a) the bid package (the complex project for which the general contractor is preparing a bid) is prepared by combining one or more bids from the subcontractors and any bid for any work to be done by the general contractor himself (example, a home builder for a custom home would perform only a portion of the home building project (foundation, wall construction, design etc.) in-house while contracting out lumber and masonry supplies etc. etc). Cook, inherently teaches this process.

(b) Cook also teaches that the general contractor communicate to each of potential supplier and subcontractor

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those portions (or modules) of the received bid package from the customer that are to be out-sourced or subcontracted. (see for example, p. 2 "those drawings that pertain to their work and their particular specification section")

(c) Cook also teaches that the (final) bid is prepared based upon combining any in-house bid and the bids received from the subcontractors (see for example p. 1, "bid day" and "submitting the bid").

Based upon the aforementioned rebuttal of the applicant's arguments, the rejection based upon Cook is maintained. Note that the applicant's argument concerning "non-monetary components" are addressed by introduction of a new reference. Accordingly this action is made final.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7 and 12-19 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Independent claims 1, 12, 13 and 14 each recite limitation "possibly a non-monetary component" which renders the claimed invention indefinite because the scope of the limitation can not be ascertained with any degree of accuracy. The examiner has interpreted this limitation to read without phrase "possibly".

Claim Rejections - 35 USC § 101

5. Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

6. The claims are rejected as not being within technological art.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or

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advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Moreover, the courts have found that a claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer. See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). Finally, the Board of Patent Appeals and Interferences (BPAI) has recently affirmed a §101 rejection finding the claimed invention to be non-statutory based on a lack of technology. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the

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component does not apply, involve, use, or advance the underlying process.

In the present case, method claims recites a process of bidding wherein the substantive part of the claimed invention (such as sequestering and preparing steps) are carried out without a computer. The use of computer (or technology) is limited to downloading the request defining a bid package while all other method steps are performed without use of the computer. Broadly interpreted this is a nominal use of the technology within the claim since critical steps of the claimed invention are carried out without use of technology or computer. **(Additional details of this requirement are also provided in previous office action.)**

Claim Rejections - 35 USC § 103

6. Claims 1-4 and 13-15 are rejected under 35

U.S.C. 103(a) as being unpatentable over Michael J Cook.

AACE International

Transactions. Morgantown: 1998. p. ES14 (7 pages) and

further in view of Carlton-Foss (US Pat. 6,647,373).

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As discussed under section "Response to Arguments", Cook teaches a process for competitive bidding substantially as recited.

Cook, however, fails to teach that the request for goods or services defining a bid package is received into a computer and explicitly teach that the in-house and the outsourced bid has a non-monetary component.

In the same field of endeavor, however, Carlton-Foss discloses an auction process and system bids are comprised of monetary component and a non-monetary component. Additionally Carlton-Foss also teaches that the request for goods and/or services defining a bid package is downloaded into a computer (see Figures 1-3 and Figure 12b).

It would have been obvious to one of ordinary skill in the art at the time of invention to have the bid prepared from combining the in-house and all the out-sourced bids wherein each in-house and all the out-sourced bid having a monetary component and a non-monetary component because this would enable the requestor to analyze the combined bid qualitatively by considering certain critical aspects of the bid such as delivery, availability, service etc. in combination with monetary amount of the price. Receiving bid package over a computer would improve the accuracy and efficiency of the bidding process.

Claims 2 and 3: features of claim 2 are explicitly disclosed by Carlton-Foss which discloses pre-qualifying the potential suppliers, selective a set of potential suppliers on the statistical weight attached to each potential supplier (bidder). (see col. 6, L 56, "ratings of the bids").

See claim 1 analysis for motivation statement.

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Claim 4: transmitting the bid to a sequential buyer (see ..submitting the bid, p.1).

Claim 13 is analyzed per corresponding method claim 1.

Claims 14 and 15 are analyzed per respective method claims 1-4.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the

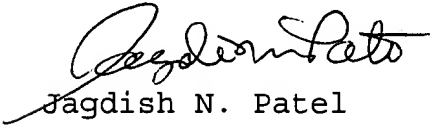
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statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571)272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jagdish N. Patel

(Primary Examiner, AU 3624)

7/8/05